REMARKS

Entry of the above amendment an allowance of this application is respectfully requested. Applicants respectfully submit that this amendment is in full compliance with Rule 116 because it raises no new issues in places both pending claims in a condition for allowance. Further, applicants respectfully submit that the Final Office Action is improper, should be withdrawn and should be reissued if the application is not immediately allowed.

First, only claims 1 and 4 are pending. In contrast, the Final Office Action imposes a rejection on now-canceled claim 2:

> 6 Claim 2 is rejected under 35 U S C. 103(a) as being unpatentable over Torrey

Because claim 2 has been canceled, the only rejection is set forth in the Final Office Action is improper.

Second, claims 1 and 4 are clearly allowable over the only prior art reference been applied against the claims, Torrey. The Patent Office admits that Torrey does not teach or suggest the application of the PSA in a swirl pattern. Claim 1 has been amended to recite a random swirl pattern as shown in the drawings

Applicants respectfully submit that the random swirl pattern shown in Figure 1 of the present application does provide a critical advantage. The swirl pattern can be applied by a moving nozzle and therefore can be applied in lesser quantities than used in Torrey By using lesser quantities, the wallpaper that is re-applied to a wall using the present invention will not have any underlined bumps or globs of adhesive that would render the re-applied wallpaper non-planar or cause undulations in the wallpaper. Thus, not only does Torrey not teach or suggest a random swirl pattern as claimed in amended claim 1, amended claim 1 provides a critical performance advantage over Torrey because it provides a reduction in the cost of materials while improving product performance.

Third, the patent on this takes the position that would have been obvious to modify Torrey to provide the PSA in a swirl pattern See the Final Office Action, pages 3-4 However, the examiner has not provided any prior art that shows the distribution or application of a PSA in a random swirl pattern. Thus, applying PSA in a random swirl pattern is not well-known in the art, is certainly not shown in the art of record and therefore there is no teaching or suggestion in the prior art to modify Torrey in the manner in which the

Patent Office proposes Thus, applicants respectfully submit that the lone rejection in the Final Office Action fails to meet the standards of MPEP § 2142, which requires:

> [t]o establish a *prima facie* case of obviousness, three basic criteria must be met First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. (*Citing, In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed Cir. 1991); *see also* MPEP § 2143-§ 2143.03 for decisions pertinent to each of these criteria.

The lone rejection in the Final Office Action fails to meet the standards of §2142 because (1) there is no suggestion to modify Torrey in the knowledge generally available to one of ordinary skill in the art because the art does not teach or suggest the application of PSA in a random swirl pattern, (2) there is no reasonable expectation of success in attempting to apply PSA in a random swirl pattern as the prior art does not teach it, and (3) the Patent Office's proposed combination and alleged reasonable expectation of success is not found in the prior art or Torrey, but is based upon the disclosure of the present application.

Thus, the rejection fails to meet the standards of §2142 on numerous fronts, is therefore improper and should be withdrawn.

The Patent Office is hereby authorized credit any overpayment or charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith to our Deposit Account No. 50-3629.

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Respectfully submitted,

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